No. 89-1603

IN THE

Supreme Court of the United States

October Term, 1989

MARIAN F. CHEW,
Petitioner,

vs.

STATE OF CALIFORNIA,
Respondent.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

REPLY BRIEF OF PETITIONER

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BASIS FOR REPLY

The Petitioner in this matter received the Respondent's response on June 28. As that response contains material arguably constituting "arguments first raised" under Supreme Court Rule 22.5, Petitioner respectfully requests consideration of the following reply brief addressed to that material.

PETITIONER HAS NO REMEDY AVAILABLE IN STATE COURT

In its Response to the Petition for Writ of Certiorari, the Respondent State of California boldly asserts that Petitioner had a state court remedy for the alleged taking of her property. Respondent relies upon *City of Oakland v. Oakland Raiders*, 32 Cal. 3d 60, 64-69, 183 Cal. Rptr. 673, 676-78, 646 P.2d 835, 837-40 (1982) as standing for the proposition that any form of property, including intangible personalty, such as patent rights, can be taken under eminent domain, provided that the "public purpose" requirement is met. *City of Oakland* bases its opinion in part upon the respected treatise *Nichols on The Law of Eminent Domain*, which Respondent graciously quotes to drive home its point. But the Respondent fails to give the Court the full flavor of Nichols.

The quotation from Nichols fails to indicate that footnotes are omitted. Even more specifically, it fails to note that the cases cited by Nichols as authority that "patent rights *** are within the scope of this sovereign authority as fully as land ***" relate to *federal* use of eminent domain over patent property. *See United States v. Burns*, 12 Wall. 246, 20 L. Ed. 388 (1871) (use of tent patent during Civil War); *James v. Campbell*, 104 U.S. 356, 26 L. Ed. 786 (1881) (use of stamping machine by Post Office) and *Calhoun v. United States*, 453 F.2d 1385 (Ct.Cl. 1972) (use of O-rings in military airplane engines). Respondent also fails to note that a State's power under eminent domain is not without limits. For example, a State's power to condemn federal lands within its territorial limits is "at present denied no matter what the

present federal use may be unless the federal government consents to such condemnation." 1 *Nichols on Eminent Domain* (3d rev. ed. 1989) Sec. 2.22, p. 2-134.

Certainly Petitioner does not believe that her patent is analogous to federal property. But she does believe that her patent right is a statutory grant made by the federal government under exclusive authority granted by citizens of the Respondent State when they accepted our federal Constitution.

Respondent has not been able to present any case laws, from any of the fifty States, where a party has presented a case for patent "taking" or "inverse condemnation" in a State court. To the contrary, extensive law exists to support the position that State courts will not entertain lawsuits that purport to enforce patent rights under various guises. *See*, for example, *Miracle Boot Puller Co. Ltd. v. Plastray Corp.*, 269 N.W.2d 496, 84 Mich. App. 118 (1978) and *Burke v. Pittway Corp.*, 380 N.E.2d 1, 20 Ill. Dec. 324, 63 Ill. App. 3d 354, *cert. denied*, 441 U.S. 908. If the federal preemption of patent law from *Sears Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964), which was affirmed last year in *Bonito Boats, Inc. v. Thundercraft Boats, Inc.*, _____ U.S. _____, 109 S. Ct. 971 (1989), is to have meaning, the supremacy of federal patent law must again be asserted by this Court.

CONCLUSION

Respondent has failed to show any instance of a patent "taking" claim being sustained in any State, so Respondent's argument that Petitioner has a State remedy must fail as being merely speculative. The Writ should issue to protect the supremacy of the federal patent system.

Respectfully submitted,

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